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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,175	04/13/2004	Mark Reddington	061873-5011US	6341
43850 7590 02/07/2007 MORGAN, LEWIS & BOCKIUS LLP (SF) 2 PALO ALTO SQUARE 3000 El Camino Real, Suite 700 PALO ALTO, CA 94306			EXAMINER JONES, DAMERON LEVEST	
			ART UNIT	PAPER NUMBER
			1618	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/07/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/824,175

Applicant(s)

REDDINGTON ET AL.

Examiner

D. L. Jones

Art Unit

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/7/05 and 12/2/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 2-17, 24-28 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 18-23 and 29-40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the preliminary amendment filed 12/2/04 wherein the specification was amended.

Note: Claims 1-41 are pending.

APPLICANT'S INVENTION

2. Applicant's invention is directed to xanthene dyes and uses thereof.

COMMENTS/NOTES

3. The search was not extended beyond the xanthene dye and uses thereof wherein the R3 = Z2R16; Z2 = oxygen; R16 = H; X = oxygen; R1, R2, R6, R7, R8, R9, R10, R11, and R12 = H; Y = C(O); and R13 = alkyl bound to a carrier molecule which is a bile acid. Thus, all other claims were withdrawn from consideration.

WITHDRAWN CLAIMS

4. Claims 2-17, 24-28, and 41 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention/species.

102 REJECTIONS

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Glombik et al (US Patent No. 5,610,151).

Glombik et al disclose bile acid derivatives that may be used as medicaments (see entire document, especially, abstract). The bile acid derivatives have the formula Z-X-GS wherein GS is a bile acid radical, X is a covalent bond or a bridge group of the formula (CH₂)_n and Z may contain a xanthene dye (column 1, lines 45-53; column 4, line 1). In Example 6, column 7, a bile acid residue is disclosed. In column 28, Example 55, a xanthene dye is disclosed wherein R₃ = Z₂R₁₆; Z₂ = oxygen; R₁₆ = H; X = oxygen; R₁, R₂, R₆, R₇, R₈, R₉, R₁₀, R₁₁, and R₁₂ = H; and Y = C(O). The xanthene dye has attached thereto a NH-(CH₂)₆-R₁ substituent wherein the substituent contains an alkyl bound to a carrier molecule which is a bile acid (this is represented by Applicant's variable R₁₃). Also, it should be noted that the R₁ variable in Example 55 (column 28) is the R₁ group (bile acid residue) that is disclosed in column 7, line 64. Thus, both Applicant and Glombik et al disclose a xanthene dye encompassed by independent claim 1 which is bound to a bile acid carrier.

CLAIM OBJECTIONS

7. Claims 18-23 and 29-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Note: It should be noted that the claims were only examined to the extent for a xanthene dye wherein R₃ = Z₂R₁₆; Z₂ = oxygen; R₁₆ = H; X = oxygen; R₁, R₂, R₆,

R7, R8, R9, R10, R11, and R12 = H; Y = C(O); and R13 = alkyl bound to a carrier molecule which is a bile acid.

COMMENTS/NOTES

8. It should be noted that the claims were only examined to the extent for the xanthene dye wherein R3 = Z2R16; Z2 = oxygen; R16 = H; X = oxygen; R1, R2, R6, R7, R8, R9, R10, R11, and R12 = H; Y = C(O); and R13 = alkyl bound to a carrier molecule which is a bile acid. The search was not further expanded because prior art was found which could be used to reject Applicant's claims.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



D. L. Jones
Primary Examiner
Art Unit 1618

January 31, 2007